

## REMARKS

### I. Introduction

Claims **5-6, 29, 31-34, 36-41**, and **43-50** are currently pending in the present application. Claims **5, 29, 31-34, 36-41**, and **43-49** are independent.

- Claims **5-6, 29, 34**, and **41** are allowed.
- Claims **31-33, 36-40**, and **43-50** stand rejected. In particular:

(A) claims **49-50** stand rejected under 35 U.S.C. §102(b) for allegedly being anticipated by U.S. Patent No. 5,732,398 (hereinafter "Tagawa"); and

(B) claims **31-33, 36-40**, and **43-48** stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Tagawa.

Upon entry of this amendment, which is respectfully requested, new claims **51-63** will be added. No new matter is believed to be introduced by this amendment.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.114.

### II. The Examiner's Rejections

#### *A. Rejections under §102(b)*

Claims **49-50** stand rejected under 35 U.S.C. §102(b) for allegedly being anticipated by Tagawa. Applicants traverse this ground for rejection as follows.

Initially, Applicants respectfully note that Tagawa is not a proper §102(b) reference. Tagawa did not, for example, publish more than one year prior to the effective filing date of the present application (*i.e.*, the effective filing date is July 8, 1997, while Tagawa did not publish until March 24, 1998). Accordingly, Applicants respectfully request that the present §102(b) grounds for rejection be withdrawn.

Further, the Examiner simply fails to apply the cited reference to the limitations of claims **49-50**. The Examiner makes broad, conclusory statements (Final Office Action mailed January 4, 2006 as Part of Paper No./Mail Date 12192005 (hereinafter the "Final Office Action"), bullet three, pgs. 6-7) regarding the general teachings of Tagawa, yet

fails to provide support for these statements and fails to directly address *any* of the limitations of claims **49-50**.

For example, claims **49-50** recite, basically, receiving **two different product descriptions for the same product**, and, based on these descriptions, determining **two different prices for the same product**. The Examiner does not address these features of claims **49-50** and does not make any showing as to how Tagawa is believed to anticipate these features. Applicants have reviewed Tagawa and have found no teaching or suggestion that reads on the claimed limitations of claims **49-50**.

Accordingly, as the Examiner has failed to show how all the limitations of claims **49-50** are taught by the cited reference, the Examiner has failed to set forth a *prima facie* case for anticipation. At least for these reasons, Applicants respectfully request that these §102(b) rejections of claims **49-50** be withdrawn.

### ***B. Rejections under §103(a)***

Claims **31-33**, **36-40**, and **43-48** stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Tagawa. Applicants traverse this ground for rejection as follows.

The Examiner has admitted (Final Office Action, pg. 2, last paragraph) that Tagawa fails to teach the claimed limitations being conducted in the recited order. The Examiner believes, however, that the order of the process steps recited in the claims is obvious. *Id.* The Examiner states, for example, “the order of these functions is left to the individual business person having a desire to operate his/her business in this manner. Such does not require any steps to be performed or does not limit the claim to a particular structure, and thus attributes to no patentable difference apart from Tagawa.” *Id.*, at pg. 3, last six lines.

Applicants respectfully note that “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)”. MPEP §2141.02 (I); emphasis in original. See also *Jones v. Hardy*, 727 F.2d

1524, 1530, 220 USPQ 1021, 1026 (Fed. Cir. 1984) ("treating the advantage as the invention disregards statutory requirement that the invention be viewed 'as a whole'"). MPEP §2141.02 (II).

In the present case, by picking and choosing alleged teachings of Tagawa to show how each limitation of the pending claims is allegedly suggested, without regard for the order or manner in which such teachings are applied in Tagawa, the Examiner has utterly failed to address whether the claimed embodiments "**as a whole**" would have been obvious. In other words, even if Tagawa taught or suggested every limitation of the pending claims (which Applicants maintain it does not), in the absence of any *proof* by the Examiner that the claimed embodiments as a whole would have been obvious, no *prima facie* case for obviousness has been established. In this case, the Examiner has not, even though Applicants have requested it, provided any such evidence (Applicants respectfully note that the Examiner's assertions do not qualify as proof or evidence).

Accordingly, as the Examiner has failed to show how the embodiments set forth in claims **31-33**, **36-40**, and **43-48** are obvious "**as a whole**", the Examiner has failed to set forth a *prima facie* case for obviousness. At least for these reasons, Applicants respectfully request that these §103(a) rejections of claims **31-33**, **36-40**, and **43-48** be withdrawn.

### III. New Claims

New claims **51-63** are believed to be patentable over the cited reference at least for the reasons otherwise presented herein. Further, after reviewing the cited reference, Applicants believe that the cited reference fails to teach, suggest, or render obvious at least:

(i) *determining transaction information associated with (i) a buyer who has arranged to purchase a product from a central controller at a first price established between the buyer and the central controller and (ii) a merchant that offers the product for sale at a second price, different from the first price, without offering the product for sale to buyers at the first price (claims 51-54);*

(ii) *arranging for the buyer to provide (i) the first price for the product if the credit card number is associated with the product, and (ii) the second price for the product if the credit card number is not associated with the product (claim 55); or*

(iii) *arranging for the buyer to take possession of the product at a retailer, the retailer being a different entity from the purchasing system, wherein the retailer offers, to buyers that do not establish the first price with the purchasing system, the product for sale at a second price that is different than the first price (claims 56-63).*

#### IV. Conclusion

At least for the foregoing reasons, it is submitted that all pending claims are now in condition for allowance, *or in better form for appeal*, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via electronic mail at [cfincham@walkerdigital.com](mailto:cfincham@walkerdigital.com), at the Examiner's convenience.

#### V. Petition for Extension of Time to Respond

While no fees are believed to be due at this time, please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

Respectfully submitted,

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Date

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